

## REMARKS

This Response is submitted in reply to the Final Office Action dated May 12, 2009, and in conjunction with the enclosed Request for Continued Examination. Applicant has amended claims 1, 11, and 21. Claim 25 was previously cancelled. No new matter is added by these amendments. A Supplemental Information Disclosure Statement is submitted herewith. Please charge Deposit Account No. 02-1818 for all payments due in connection with this Response, this Request for Continued Examination, and this Supplemental Information Disclosure Statement.

As noted above, Applicant has filed a Request for Continued Examination with this Response. Accordingly, Applicant requests that if the Examiner does not allow this application, the Examiner provide an upcoming Office Action which will "... identify any claims which he or she judges, as presently recited, to be allowable and/or ... suggest any way in which he or she considers that rejected claims may be amended to make them allowable" in accordance with §707.07(d) of the MPEP.

### **Claim Rejections Under 35 U.S.C. § 102**

The Office Action rejected Claims 1 to 4, 9, 10, 21 to 24, 30 to 33, 36, and 37 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,393,057 to Marnell ("Marnell"). Applicant respectfully disagrees with and traverses this rejection. Nevertheless, to advance prosecution, Applicant has amended certain of the claims for clarity.

Marnell discloses an electronic gaming apparatus which includes:

a display and input buttons for play of a primary game, such as a poker game; and electronic secondary gaming device, such as a bingo-type gaming device, including a display, such as a bingo matrix having a plurality of spaces. The poker gaming device and the bingo-type gaming device are electrically connected together. In one embodiment of the invention, the bingo matrix spaces are filled by a random generator device with indicia related to the primary gaming device. When predetermined results occur in the primary game, such as a poker hand or slot machine set of reels, these results are automatically entered in the secondary game.

Marnell discloses that the secondary game includes "game simulations which are based upon, connected with, or derived from, a conventional bingo game." Marnell, column 5, lines 29 and 30. If a poker hand of the primary game of Marnell meets the poker game criteria for a winning hand, the occurrence of the winning hand "either enables or automatically produces an entry into bingo matrix 51, if the bingo matrix also includes the winning hand." Marnell, column 5, lines 65 to 68. If the bingo matrix includes duplicate indicia representing the winning poker hand, Marnell discloses that a random computer selection or user selection could be made as between duplicates. See Marnell, column 5, lines 51 to 60. In Marnell, the player "may continue to play poker gaming apparatus 22 until a BINGO is achieved in bingo gaming apparatus 23, at which point game apparatus 21 will award money, awards or benefits for winning the bingo game." Marnell, column 6, lines 18 to 22. Marnell further discloses that "[o]nce the predetermined coin or credit input is made, the microprocessor and image generator will fill spaces 52 in bingo matrix 51 with indicia 53 representing randomly selected winning poker hands which are randomly distributed throughout matrix 51." Marnell, column 5, lines 51 to 55.

Page 3 of the Office Action states that "Marnell teaches the player's automatic participation in the bonus game with the occurrence of qualifying events..." (Emphasis added). Page 3 of the Office Action further states that "[t]he claimed characterization that a player causes the play of the bonus game responsive to the occurrence of a qualifying event, is understood to encompass the automatic player participation in the bonus event resultant of the players placement of a wager." (Emphasis added).

However, Applicant respectfully submits that Marnell does not generally disclose enabling a player, after the outcome of the main game is determined, to make an input to cause a play of a bonus event regardless of whether the outcome of the main game is a winning outcome. Specifically, Marnell does not disclose a method of operating a gaming system which includes, if a bonus condition occurs, after determining the outcome of the play of the main game, enabling the player to make an input using the at least one input device to cause a play of a bonus event regardless of whether the main game hand is one of the predetermined winning hands. In Marnell, the Marnell player

places a wager on the play of the main game before the Marnell gaming device determines an outcome of the play of the main game. Under the Office Action's interpretation of Marnell, this placement of the wager is the input that causes the play of the Marnell bonus event. However, Marnell does not disclose enabling the player to make an input after determining the outcome of the play of the main game to cause a play of a bonus event. That is, even if the wager placed on the play of the Marnell main game is interpreted as the input which causes play of a bonus event, Marnell does not disclose enabling the player to make the input after displaying the play of the main game.

Additionally, Page 4 of the Office Action states that "the newly claimed features directed to the random selection of bonus categories is understood to describe the step of populating the bingo matrix in Marnell." Page 4 of the Office Action also states that "the prior art of Marnell teaches that the bingo matrix is populated independently of the game results..."

Applicant respectfully disagrees and submits that Marnell does not generally disclose receiving an input after determining the outcome of the play of the main game, the input causing play of a bonus event, and the play of the bonus event comprising randomly selecting at least one of the bonus categories after receiving the input from the player to cause the play of the bonus event. Specifically, even if the population of the Marnell bingo matrix is interpreted as a random selection of a bonus category, Marnell does not disclose a method of operating a gaming system which includes, after determining the outcome of the play of the main game, enabling the player to make an input using the at least one input device to cause a play of a bonus event, and if said input from the player to cause the play of the bonus event is received, after receiving said input from the player to cause the play of the bonus event, causing the at least one display device to display the play of the bonus event, the play of the bonus event comprising randomly selecting at least one of the bonus categories after receiving said input from the player to cause the play of the bonus event, the random selection of at least one of the bonus categories being in addition to and independent of any previously displayed play of the main game.

As stated above, the Marnell gaming device fills the bingo matrix with indicia “[o]nce the predetermined coin or credit input is made.” Marnell, column 5, lines 51 to 55. That is, the Marnell gaming device “populates” the bingo matrix upon the player’s placement of a wager before the play of the main game. Even if populating the Marnell bingo matrix is interpreted as a random selection of at least one of the bonus categories, the random selection occurs before the play of the main game. On the other hand, in accordance with the method of operating a gaming system of amended independent Claim 1, the random selection of at least one of the bonus categories occurs after determining the outcome of the play of the main game. Specifically, amended independent Claim 1 is directed to a method which generally includes enabling the player to make an input to cause the play of the bonus event after determining the outcome of the play of the main game, and if the input from the player to cause the play of the bonus event is received, causing the play of the bonus event, the play of the bonus event comprising randomly selecting at least one of the bonus categories. That is, the random selection of at least one of the bonus categories occurs after the outcome of the play of the main game is determined because the random selection of at least one of the bonus categories occurs after receiving the input from the player to cause play of the bonus event, and the player causes play of the bonus event after the outcome of the play of the main game is determined.

Therefore, unlike the method of amended independent Claim 1, the method of Marnell does not disclose a method of operating a gaming system which includes, after determining the outcome of the play of the main game, enabling the player to make an input using the at least one input device to cause a play of a bonus event, and ) if said input from the player to cause the play of the bonus event is received, after receiving said input from the player to cause the play of the bonus event, causing the at least one display device to display the play of the bonus event, the play of the bonus event comprising randomly selecting at least one of the bonus categories after receiving said input from the player to cause the play of the bonus event, the random selection of at least one of the bonus categories being in addition to and independent of any previously displayed play of the main game.

For at least these reasons, amended independent Claim 1 is patentably distinguished over Marnell and is in condition for allowance. Claims 2 to 4, 9, 10, 32, and 33 depend directly and indirectly from amended independent Claim 1 and are allowable for similar reasons, and because of the additional features recited in these claims.

Amended independent Claim 21 recites certain similar features as amended independent Claim 1 and is allowable for similar reasons. Claims 22 to 24, 30, 31, 36, and 37 depend directly and indirectly from amended independent Claim 21 and are allowable for similar reasons, and because of the additional features recited in these claims.

### **Claim Rejections Under 35 U.S.C. § 103**

The Office Action rejected Claims 11 to 14, 19, 20, and 34 to 35 under 35 U.S.C. § 103(a) as being unpatentable over Marnell. Applicant respectfully disagrees with and traverses this rejection. Nevertheless, to advance prosecution of this application, Applicant has amended certain of these claims for clarity.

Page 6 of the Office Action states that Marnell "is silent regarding the inclusion of a bonus category wherein said bonus category is associated with a value which represents a combination of all remaining bonus categories." As stated on Page 6 of the Office Action, "[t]he Examiner gives official notice that the utilization of coverall/blackout pattern is exceptionally old and well known in the art of Bingo." Page 7 of the Office Action concludes that "it would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated coverall/blackout bingo pattern into the invention of Marnell at the time of invention because such a combination of wild symbols and symbol categories would have represented the use of known gaming features combined in conventional manners to yield the predictable [result] of providing a bonus category that would yield an instant win regardless of the bingo target pattern."

Applicant respectfully disagrees and submits that regardless of whether it would have been obvious to modify Marnell to include a coverall/blackout pattern, as stated above with respect to amended independent Claim 1, unlike the method of operating a

gaming system of amended independent Claim 11, Marnell does not disclose or suggest a method of operating a gaming system which includes, after determining the outcome of the play of the main game, enabling the player to make an input using the at least one input device to cause a play of a bonus event, and ) if said input from the player to cause the play of the bonus event is received, after receiving said input from the player to cause the play of the bonus event, causing the at least one display device to display the play of the bonus event, the play of the bonus event comprising randomly selecting at least one of the bonus categories after receiving said input from the player to cause the play of the bonus event, the random selection of at least one of the bonus categories being in addition to and independent of any previously displayed play of the main game. The Examiner's official notice does not cure the deficiencies of Marnell. Moreover, it would not have been obvious to one having ordinary skill in the art to have modified Marnell with the Examiner's official notice to arrive at such a method without reasonably being construed as impermissible hindsight reconstruction.

For at least these reasons, amended independent Claim 11 is patentably distinguished over these references, and is in condition for allowance. Claims 12 to 14, 19, 20, and 34 to 35 depend directly and indirectly from amended independent Claim 11 and are allowable for similar reasons, and because of the additional features recited in these claims.

The Office Action rejected Claims 5 to 8, 15 to 18, and 26 to 29 under 35 U.S.C. § 103(a) as being unpatentable over Marnell in view U.S. Patent No. 6,419,579 to Bennett ("Bennett"). Applicant respectfully disagrees with and traverses these rejections. Nevertheless, to advance prosecution, Applicant has amended certain of the independent claims, from which these claims depend, for clarity.

As described above, Marnell discloses an electronic gaming apparatus which includes a primary game and a secondary game, such as a bingo-type game. If a poker hand of the primary game meets the poker game criteria for a winning hand, the occurrence of the winning hand either enables or automatically produces an entry into the bingo matrix, if the bingo matrix also includes the winning hand. Bennett discloses a

bonus event wherein a symbol, such as one or more dice, is displayed to indicate a multiplier, which is used in combination with a value generated in a main game to determine an additional payout amount.


Page 8 of the Office Action states that Marnell is "silent regarding the utilization of two dice to determine a multiplier utilized in combination with a bonus winning to determine an additional payout amount or equivalently described as a score." The Office Action further states that "it would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the utilization of dice to determine a supplemental prize multiplier as taught by Bennett into the invention of Marnell in order to maintain a player interest in a gaming machine as taught by Bennett". Applicant respectfully disagrees and submits that regardless of whether it would have been obvious to incorporate the utilization of dice to determine a supplemental prize multiplier into Marnell, unlike the methods of operating a gaming system of Claims 5 to 8, 15 to 18, and 26 to 29, Marnell and Bennett, alone or in combination, do not disclose or render obvious a method of operating a gaming system which includes, after determining the outcome of the play of the main game, enabling the player to make an input using the at least one input device to cause a play of a bonus event, and ) if said input from the player to cause the play of the bonus event is received, after receiving said input from the player to cause the play of the bonus event, causing the at least one display device to display the play of the bonus event, the play of the bonus event comprising randomly selecting at least one of the bonus categories after receiving said input from the player to cause the play of the bonus event, the random selection of at least one of the bonus categories being in addition to and independent of any previously displayed play of the main game. Moreover, it would not have been obvious to one of ordinary skill in the art to modify Marnell in view of Bennett to result in such methods of operating a gaming system without reasonably being construed as improper hindsight reconstruction.

For at least these reasons, and because of the additional features recited in these claims, Claims 5 to 8, 15 to 18, and 26 to 29 are patently distinguished over Marnell in combination with Bennett, and are in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance, which is courteously solicited. If the Examiner has any questions regarding this Response, Applicant respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

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